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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,693	02/27/2004	Frederick Pohlman	0521-01UA	7033

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EXAMINER

ALI, SHUMAYA B

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/788,693

Applicant(s)

POHLMAN, FREDERICK

Examiner

Shumaya B. Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4,5,13,14 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-12,15-17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> . |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: **Species 1: figure 2; species 2: figure 3; species 3: figure 5; species 4: figures 6 and 7;**
2. If the applicant chooses to elect species 1, applicant is further required to elect one of the figures from each of the following subspecies: **subspecies 1a: figure 4a or 4b; subspecies 1b: figures 8 or 9.**
3. If the applicant chooses to elect species 2, applicant is further required to elect one of the figures from the following subspecies: **subspecies 2a: figure 4a or 4b;**
4. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1,2,6,7,9,10,11,15, and 16 are generic.
5. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
6. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
7. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants

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or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

8. During a telephone conversation with Eric Karich on 3/29/2005 a provisional election was made without traverse to prosecute the invention of species 1, subspecies 1a: figure 4b, and subspecies 1b: figure 8, claims 3,8,12,17, and 19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4,5,13,14,and18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,6-7,8-12,15-17,19,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopelowicz US Patent 5,873,364 in view of Alla et al. US Patent 5,992,415.

10. **As to claim 1, Kopelowicz discloses** a sheathing device for use with a condom to form a prophylactic device adapted to separate a penis from a vagina, the sheathing device comprising: a liner body **(see fig.1 reference object 2)** substantially comprising a textile material **(woven fabric, see col.1 lines 40-43,col.2 lines 30-34)** and having an open end **(fig.1 seems to depict an open end near reference object 1)**, a closed end **(fig.1 seems to depict a domed shaped close end near reference object 2)**, and a generally tubular shape **(see col.4 line 1)** adapted to receive the penis **(see col.1 lines 20-**

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21); however does not disclose an inner lubricant layer substantially covering the closed end of the liner body; and a means for anchoring the open end outside the vagina.

11. **As to claim 1, Alla et al. teach** a prophylactic device with an open end (see fig.1 reference object 16) having a frame (reciting the limitation "means for anchoring the open end; the construction of the frame with flanged rigid materials prevents the open end of the device from going into the vagina) (see fig.6 reference object 24) that aids in positioning the device on a user prior to deployment (see col.3 lines 53-54). Additionally teach a circular sponge (see fig.2 reference object 28) configured to fit into a closed end and to be shaped in a manner for ease of condom installation and retention following installation (see col.2 lines 64-67). The sponge is formed of a resilient, porous material (see col.4 lines 27-28) may be impregnated with lubricant or other antibacterial agents that can be slowly released to protect a user (see col.4 lines 35-38). **Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in view of Alla et al. in order to provide the device with an inner lubricant layer, a sponge positioned at the closed end of the device impregnated with lubricant or antibacterial agents for the purposes of protecting a user from infectious agent, also it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in order to provide an anchoring means, a frame incorporated at the open end of the device as taught by Alla et al for the purposes of positioning the device on a user prior to deployment.**

12. **As to claim 2, Kopelowicz discloses** the sheathing device as recited in claim 1, wherein the textile material comprises elastic textile fibers (see col.2 lines 30-34).

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13. **As to claim 3, Kopelowicz does not disclose** the sheathing device as recited in claim 1, wherein the means for anchoring the open end outside the vagina comprises a ring adapted to be attached to the open end of the liner body and dimensioned to fit around the penis but not fit into the vagina.

14. **As to claim 3, Alla et al. teach** a prophylactic device with an open end (see fig.1 reference object 16) having a frame (reciting the limitation "means for anchoring the open end; the construction of the frame with flanged rigid materials/v-shaped spring, reciting the limitation "ring" that prevents the open end of the device from going into the vagina) (see fig.6 reference object 24) that aids in positioning the device on a user prior to deployment (see col.3 lines 53-54. **Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in order to provide a ring or a frame incorporated at the open end of the device as taught by Alla et al for the purposes of anchoring the open end of the device outside the vagina and positioning the device on a user prior to deployment.**

15. **As to claim 6, Kopelowicz does not disclose** the sheathing device as recited in claim 1, further comprising a means for anchoring the closed end of the liner body within the vagina.

16. **As to claim 6, Alla et al. teach** a prophylactic device/female condom with a sponge (see fig.2 reference object 28) configured to fit into a closed end and to be shaped in a manner for ease of condom installation and retention (see col.2 lines 64-67) to the vagina canal during and following installation (see col.2 lines 13-14) following installation. **Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in order to provide the device with an anchoring means at the closed end as taught by Alla et al. for the purposes of allowing easy installation and retention of the device to the vaginal canal.**

17. **As to claim 7, Kopelowicz does not disclose** the sheathing device as recited in claim 6, wherein the means for anchoring the closed end of the liner body within the vagina comprises a resilient body adapted to fit within the closed end and fixedly position the liner body within the vagina.

18. **As to claim 1, Alla et al. teach** a retention sponge (see fig.2 reference object 28) can be formed of a resilient, porous material (see col.4 lines 27-29) and shaped at different points within the vaginal canal during insertion so as to allow smooth comfortable insertion (see col.3 lines 25-28). **Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in view of Alla et al. in order to provide the device with a resilient anchoring means at the closed end so that the resilient means can be shaped at a different points within the vaginal canal as taught by Alla et al. for the purposes of allowing smooth comfortable insertion.**

19. **As to claim 8, Kopelowicz discloses** a prophylactic device, comprising: a liner body substantially comprising a textile material and having an open end, a closed end, and a generally tubular shape adapted to receive the penis; and a liquid impervious barrier (latex layer, see col.2 lines 42-43) positioned around the liner body, **however does not disclose** an inner lubricant layer substantially covering the closed end of the liner body;

20. **As to claim 8, Alla et al. teach** a prophylactic device with a circular sponge (see fig.2 reference object 28) configured to fit into a closed end and to be shaped in a manner for ease of condom installation and retention following installation (see col.2 lines 64-67). The sponge is formed of a resilient, porous material (see col.4 lines 27-28) may be impregnated with lubricant or other antibacterial agents that can be slowly released to protect a user (see col.4 lines 35-38). **Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of**

Kopelowicz in view of Alla et al. in order to provide the device with an inner lubricant layer, a sponge positioned at the closed end of the device impregnated with lubricant or antibacterial agents for the purposes of protecting a user from infectious agent

21. **As to claim 9, Kopelowicz discloses** the prophylactic device as recited in claim 8, wherein the textile material comprises elastic textile fiber **(see col.2 lines 30-34).**

22. **As to claim 10, Kopelowicz discloses** the prophylactic device as recited in claim 8, wherein the liquid impervious barrier layer is formed integrally with the liner body **(see col.2 lines 42-43).**

23. **As to claim 11, Kopelowicz does not disclose** the prophylactic device as recited in claim 8, further comprising a means for anchoring the open end outside the vagina.

24. **As to claim 11, Alla et al. teach** a prophylactic device with an open end (see fig.1 reference object 16) having a frame (reciting the limitation "means for anchoring the open end; the construction of the frame with flanged rigid materials prevents the open end of the device from going into the vagina) (see fig.6 reference object 24) that aids in positioning the device on a user prior to deployment (see col.3 lines 53-54). **Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in order to provide an anchoring means, a frame incorporated at the open end of the device as taught by Alla et al for the purposes of positioning the device on a user prior to deployment.**

25. **As to claim 12, Kopelowicz does not disclose** the prophylactic device as recited in claim 11, wherein the means for anchoring the open end outside the vagina comprises a ring adapted to be attached to the open end of the liner body and dimensioned to fit around the penis and not fit into the vagina.

26. **As to claim 12, Alla et al. teach** a prophylactic device with an open end (see fig.1 reference object 16) having a frame (reciting the limitation "means for anchoring the open end; the construction of the

fame with flanged rigid materials/v-shaped spring, reciting the limitation "ring" that prevents the open end of the device from going into the vagina) (see fig.6 reference object 24) that aids in positioning the device on a user prior to deployment (see col.3 lines 53-54. **Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in order to provide a ring or a frame incorporated at the open end of the device as taught by Alla et al for the purposes of anchoring the open end of the device outside the vagina and positioning the device on a user prior to deployment.**

27. **As to claim 15, Kopelowicz does not disclose** the prophylactic device as recited in claim 8, further comprising a means for anchoring the closed end of the liner body within the vagina.

28. **As to claim 15, Alla et al. teach** a prophylactic device/female condom with a sponge (see fig.2 reference object 28) configured to fit into a closed end and to be shaped in a manner for ease of condom installation and retention (see col.2 lines 64-67) to the vaginal canal during and following installation (see col.2 lines 13-14) following installation. **Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in order to provide the device with an anchoring means at the closed end as taught by Alla et al. for the purposes of allowing easy installation and retention of the device to the vaginal canal.**

29. **As to claim 16, Kopelowicz does not disclose** the prophylactic device ms recited in claim 15, wherein the means for anchoring the closed end of the liner body within the vagina comprises a resilient body adapted to fit within the closed end and fixedly position the liner body within the vagina.

30. **As to claim 16, Alla et al. teach** a retention sponge (see fig.2 reference object 28) can be formed of a resilient, porous material (see col.4 lines 27-29) and shaped at different points within the vaginal canal during insertion so as to allow smooth comfortable insertion (see col.3 lines 25-28). **Therefore, it would**

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have been obvious to one of ordinary skills in the art at the time the invention was made to modify the prophylactic device of Kopelowicz in view of Alla et al. in order to provide the device with a resilient anchoring means at the closed end so that the resilient means can be shaped at a different points within the vaginal canal as taught by Alla et al. for the purposes of allowing smooth comfortable insertion.

31. As to claim 17, Kopelowicz does not disclose the prophylactic device as recited in claim 8, wherein the liquid impervious barrier layer comprises a condom

32. As to claim.17, Alla et al. teach a prophylactic device, female condom (see col.1 lines 3-5) with a shield portion that has an inner surface and an outer surface respectively forming the front and rear panels of a condom for covering the perineum region of a user (see col.2 lines 51-53). Therefore, it would have been obvious to one of ordinary skills in art at the time the invention was made to modify the device of Kopelowicz in view of Alla et al. in order to provide a liquid impervious barrier layer comprising a condom for the purposes of preventing liquid penetration into the vagina, an inherent functional purpose of a condom.

Conclusion

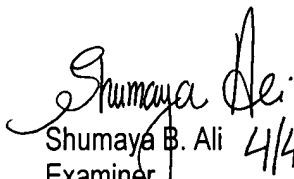
32. The prior art made of record on form PTO-892 and not relied upon shows prophylactic device.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Shumaya B. Ali** whose telephone number is **571-272-6088**. The examiner can normally be reached on M-F 8:30 am-4: 30 pm.

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34. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Henry Bennett** can be reached on **571-272-4791**. The fax phone number for the organization where this application or proceeding is assigned is 571-273-6088.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shumaya B. Ali
Examiner
Art Unit 3743
4/4/2005


Henry Bennett
Supervisory Patent Examiner
Group 3700